

REMARKS

Claims 22-73 are pending in the Application and all have been rejected in the Office action mailed July 9, 2007. Claims 60 and 70 are amended by this submission.

Claims 22, 28, 29, 36, 43, 47, 51 and 60 are independent claims. Claims 23-27, 30-35, 37-42, 44-46, 48-50, 52-59 and 61-73 depend, respectively, from independent claims 22, 29, 36, 43, 47, 51 and 60.

The Applicants respectfully request reconsideration of the pending claims 22-73, in light of the following remarks.

Amendments to the Claims

Claims 60 and 70 have been amended as shown above, at the request of the Office, to correct a minor claim drafting error, and to further clarify the subject matter of the claim. Support for the amendment of claim 60 may be found, for example, on pages 299 and 300 of the Specification. Applicants respectfully submit that these amendments do not add new matter.

Objection to the Claims

Claims 60 and 70 were objected to by the Office. Applicants respectfully submit that claims 60 and 70 have been amended, that the objections to claims 60 and 70 have been overcome, and respectfully request that the objections to claims 60 and 70 be reconsidered and withdrawn.

Rejections of Claims

Rejections Under 35 U.S.C. §103(a)

Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken (WO 91/08629) in view of Richter, et al. (US 6,104,706, hereinafter "Richter"). Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Harrison et al. (US 5,796,727, hereinafter "Harrison"). Claims 27, 35, 42, 51, and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of

Richter and Weaver et al. (US 5,956,673, hereinafter "Weaver"). Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Perkins (US 5,159,592). Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter, Harrison, and Perkins. Claims 52 and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter, Weaver, and Perkins. Claims 55 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Cripps (US 5,838,730). Claims 60, 61, 62, and 68-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton et al. (US 6,108,704, hereinafter "Hutton"). Claims 63-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Lewen et al. (US 5,341,374, hereinafter "Lewen"). Claim 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, Lewen, and McKee et al. (US 5,477,531, hereinafter "McKee"). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Cripps. Applicants respectfully traverse the rejections.

The Applicant respectfully submits that the Examiner has failed to establish a case of prima facie obviousness for at least the reasons set forth below. M.P.E.P. §2142 clearly states that "[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." The M.P.E.P. §2142 goes on to state that "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

With regard to claims 22, 28, 29, 36, 43, 47, and 51, Applicants respectfully submit that the Office has failed to establish a prima facie case of obviousness, as

Appln. No. 10/701,865
Filed: November 5, 2003
Reply to Office action mailed July 9, 2007
Amendment filed January 9, 2008

required by M.P.E.P. §2142, and that claims 22, 28, 29, 36, 43, 47, and 51 define allowable subject matter, for at least the reasons set forth during prior prosecution, and in addition, for those that follow.

More specifically, Applicants respectfully submit that Richter (US 6,104,706) is not, in and of itself, valid prior art, and that the Office cites Richter based upon a claim of priority to the filing date of an abandoned application that is not available for inspection by the Applicants. Therefore, Applicants respectfully submit that Applicants have not been provided with "...such information and references as may be useful in judging of the propriety of continuing the prosecution of his application ...", as required under 35 U.S.C. §132.

Applicants respectfully submit that the instant application, which was filed November 5, 2003, is a continuation of U.S. Patent Application No. 10/141,506 (the "506 application") filed May 8, 2002, which is a continuation of U.S. Patent Application No. 09/037,535 (the '535' "application") filed March 10, 1998, which is a continuation of U.S. Patent Application No. 08/539,817 (the "817 application") filed October 5, 1995. Applicants respectfully submit that the claims of the Application are fully supported by the disclosure of the '817 application. Therefore, Applicants respectfully submit that the effective date of priority of the instant application is October 5, 1995.

In view of Applicants' effective priority date, Applicants respectfully submit that the Richter reference cited in the Office action, U.S. Patent No. 6,104,706, filed as U.S. Application No. 09/437,269 (the "'269 reference") on November 10, 1999, is not valid prior art. The '269 reference, however, is a continuation of and claims priority to U.S. Patent Application No. 08/626,580 (the "'580 reference"), filed April 2, 1996. Applicants respectfully submit that, in view of Applicants' effective date of priority, the '580 reference is also not valid prior art. The '580 reference, however, is a continuation application claiming priority to U.S. Patent Application No. 08/073,956 (the "'956 reference"), filed June 9, 1993. Therefore, it appears that the Office relies upon a claim to the filing date of the '956 reference, the only application in the chain of continuation applications filed by Richter that has a priority date predating Applicants' priority date of October 5, 1995. The '956 reference was expressly abandoned on June 27, 1996. The

Office did not provide access to a copy of the '956 reference, and the '956 reference is not available through PAIR. The Office, however, cited and provided access to the disclosure of the '269 reference, not the '956 reference used to support the rejection.

Applicants respectfully submit that Applicants have not been provided with a copy of the '956 reference by the Office, and are unable to retrieve a copy of the '956 reference. Therefore, Applicants have not been given a fair opportunity to review the only possible valid prior art in the chain of priority of Richter, and that Richter has not been provided to the Applicants as required by 35 U.S.C. §132. Therefore, Applicants respectfully submit that Richter is not a valid prior art reference under 35 U.S.C. §103(a), and that the Office has failed to establish a prima facie case of obviousness, as required under M.P.E.P. §2142.

In addition, Applicants respectfully submit that the proposed combination of references fails to teach, suggest, or disclose, at least, "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets ...", as recited by Applicants' claims 22 and 28; "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets through the communication network...", as recited in Applicants' claim 29. The proposed combination of references also fails to teach, suggest, or disclose, at least, "...wherein the digital voice data is packetized according to a packet protocol comprising destination information used for routing the digital voice data packetized according to the packet protocol through the communication network...", as recited by Applicants' claim 36, "...wherein the digital voice packets comprise destination information used for routing the digital voice packets through the network...", as recited by Applicants' claim 47, and "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets through the network...", as recited by Applicants' claim 51.

With regard to claims 22, 28, 29, 36, 43, 47, and 51, the Office action asserts that Berken discloses "...wherein the digital voice packets comprises [sic] information (see FIG. 3, control time slot of frame; and/or FIG. 4, packet header of the voice time slot) used for routing the digital voice data packets (see page 9, line 1-10; see page 10, line

17-30; control time slot of the transmit/receive frame comprises control information for routing/forwarding through PSTN, Ethernet LAN, or Token Ring LAN; and/or a packet header of the voice time slot comprises control information routing/forwarding through PSTN, Ethernet LAN, or Token Ring LAN)." (Office action page 4, lines 1-7)

Applicants appreciate recognition by the Office that Berken "...does not explicitly disclose destination." (Office action at page 4, line 8) Applicants respectfully submit, however, that the Office is inconsistent in its assertions of what Berken teaches. Specifically, contrary to the statement made with respect to claims 22, 28, 29, 36, and 47, the Office action asserts with respect to claims 43 and 51 that Berken discloses "...wherein the digital voice data packets comprises destination information...." (underline added)(Office action at pages 6 and 8) Applicants respectfully submit, therefore, that the Office is inconsistent in its interpretations of the teachings of Berken, and in its assertions of what is allegedly taught by Berken. With respect to claims 43 and 51, Applicants assume that the Office meant to state that Berken "...does not explicitly disclose destination...." Applicants respectfully request that the Office notify the Applicants if this assumption is in error.

Applicants respectfully maintain that Berken teaches a wireless in-building telecommunication system for voice and data communication having at least one node and a multiplicity of user modules linked to the node via a shared RF communications path. (Abstract) Berken clearly teaches that time on the shared RF communications path is divided into frames comprising a number of time slots in a group for node transmit and a group used for node receive. Berken further teaches that each group is divided into three subgroups of control time slots, voice time slots and data time slots. (FIG. 2; page 10, lines 16-22; FIG. 3; page 9, lines 2-5) Each of the time slots is divided into four parts: bus control, packet preamble, packet header, and packet information, and the voice, data or system control information is contained in the packet information portion. (page 9, lines 6-9; page 10, line 19-20) Berken teaches that the time slots within the frames are assigned for the use of the nodes and the multiplicity of user modules according to a bandwidth allocation scheme in which, when a module requires bandwidth, it will use a predetermined control time slot to request bandwidth from the

node, and a time slot or group of time slots is then assigned to that module for its use. (Abstract; page 2, line 24 to page 3, line 18; page 9, lines 18-27; page 11, lines 3-6) Applicants respectfully submit that the individual time slots of any frame may be directed to any of a multiplicity of users.

The Office cites Fig. 3 of Berken, and more specifically, the "...control time slot of frame..." as teaching "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets ...", as recited by Applicants' claims 22 and 28; "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets through the communication network....", as recited in Applicants' claim 29; "...wherein the digital voice data is packetized according to a packet protocol comprising destination information used for routing the digital voice data packetized according to the packet protocol through the communication network...", as recited by Applicants' claim 36, "...wherein the digital voice data packets comprise destination information...", as recited by Applicants' claim 43; "...wherein the digital voice packets comprise destination information used for routing the digital voice packets through the network...", as recited by Applicants' claim 47; and "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets through the network...", as recited by Applicants' claim 51 Applicants respectfully disagree. Berken states that Fig. 3 "...shows the time slot arrangement within the frame." (page 3) Berken's Fig. 3 is shown below:

NODE TRANSMIT			FRAME			NODE RECEIVE		
CONTROL TIME SLOTS	VOICE TIME SLOTS	DATA TIME SLOTS	CONTROL TIME SLOTS	VOICE TIME SLOTS	DATA TIME SLOTS	CONTROL TIME SLOTS	VOICE TIME SLOTS	DATA TIME SLOTS

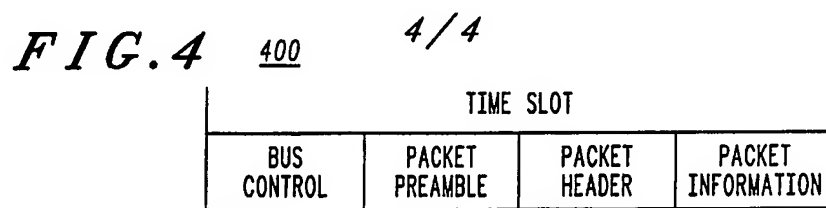
300

FIG. 3

Applicants respectfully submit that nothing in Fig. 3 (or the related text) of Berken, which was specifically cited by the Office, teaches or suggests anything with respect to a digital voice packet comprising information used for routing digital voice data packets, as alleged by the Office. Applicants respectfully maintain that, as clearly shown in Fig. 3, the control time slots of Berken are separate from the voice time slots, and that a voice packet is contained within a voice time slot within a frame, and not within a control time slot. Any information alleged to be contained within packets in the control time slot is, therefore, not contained within a voice packet, in accordance with Applicants' claims 22, 28, 29, 36, 43, 47, and 51. Therefore, this is different from and fails to teach or suggest at least this aspect of Applicants' claims 22, 28, 29, 36, 43, 47, and 51.

The Office action also cites FIG. 4 of Berken, and more specifically, the packet header of the voice time slot, as teaching "...wherein the digital voice data packets comprise information used for routing the digital voice data packets...." Applicants again respectfully disagree.

Berken states that Fig. 4 "...shows the contents within a time slot." (page 3) Berken's Fig. 4 is shown below:



Applicants respectfully submit that Fig. 4 of Berken simply shows a portion of the time slot labeled "PACKET PREAMBLE", and that nothing in Fig. 4 of Berken, which was specifically cited by the Office, makes any mention of "...information used for routing the digital voice data packets...", let alone "...digital voice data packets comprising information used for routing the digital voice data packets...", as alleged by the Office.

Applicants respectfully submit that the following portion of Berken, portions of which were selected by Office to support the rejection of Applicants' claims, describes Fig. 4:

Each time slot has the same basic format shown in Fig. 4. A time slot is divided into four parts: bus control, packet preamble, packet header, and packet information. The voice, data or system control is contained in the packet information portion.

This system allows for maximum spectral efficiency by allocating the required bandwidth to each of the users of the common communication path. As mentioned above, previous systems did not allocate on a need bases [sic], but rather allocated the bandwidth at system startup. As a result, this system takes advantage of the fast packet switching technology that allows both circuit and non-circuit connections to be made in the same system.

The control time slots are used for system control and bandwidth allocation. When a user module or interface unit requires voice or data bandwidth, it will use a predetermined control time slot to request bandwidth from the node. The node will allocate the bandwidth, if available, and notify the user module and interface unit of the bandwidth allocation via a predetermined control time slot. The user module and interface unit will use the bandwidth until it is no longer required. At that point, the user module and/or the interface unit will use a predetermined control time slot to send a de-allocation request to the node. The node will use a predetermined control time to acknowledge the de-allocation of the bandwidth to the user module and interface unit.

(Berken at page 9, lines 6-27)

Applicants respectfully submit that nothing in the text of Berken shown above, which describes the content of cited Fig. 4, nor any other figure or portion of Berken teaches or suggests anything with respect to "...wherein digital voice data packets comprise information used for routing the digital voice data packets...", as asserted by the Office with regard to Applicants' claims 22, 28, 29, 36, and 47, or "...wherein the digital voice data packets comprises [sic] destination information...", as asserted by the

Office with regard to Applicants' claims 43 and 51. Applicants respectfully submit that Berken offers no details of the contents or use of the "packet preamble" shown in Fig. 4.

The Office action also cites Berken at page 9, lines 1-10, which state (underlined):

There will be a repetitive frame occurring periodically which contains system control, voice, and data packets necessary for the correct operation of the system. The frame shown in Fig. 2 is made up of a fixed number of time slots. Fig. 3 shows how the time slots are divided into two basic groups; node transmit and node receive. Each of these two groups is further divided into three subgroups; control time slots, voice time slots, and data time slots.

Each time slot has the same basic format shown in Fig. 4. A time slot is divided into four parts: bus control, packet preamble, packet header, and packet information. The voice, data or system control is contained in the packet information portion.

This system allows for maximum spectral efficiency by allocating the required bandwidth to each of the users of the common communications path. As mentioned above, previous systems did not allocate on a need bases [sic], but rather allocated the bandwidth at system startup. As a result, this system takes advantage of the fast packet switching technology that allows both circuit and non-circuit connections to be made in the same system.

The Office action also cites page 10, lines 17-30 of Berken, which state (underlined):

Time slot assignment bandwidth allocation is described as follows:

In a fast packet communication system, the communication channel is divided into frames. Each of these frames is a given length in time. Each frame is broken into time slots. Each of these time slots contains a packet of information. This is shown in Fig. 2. All time slots are available for use by any node or module requesting bandwidth. This request can be for either voice or data transfer.

Using a time division multiple access (TDMA) scheme, the frame is divided into sections (groups of time slots), one transmit and one receive for the nodes. The nodes used their allocated portion of the frame to communicate with user modules and other nodes. As a node's requirement for bandwidth changes, its portion of the frame will increase or decrease as required. This change of the frame (time slot) allocation requires coordination between all of the nodes.

When a request is made for voice information transfer, a time slot is allocated for the duration of a call -- this is known as a "circuit switched path". When a request is made for data information transfer, a time slot is allocated for a single frame or group of frames -- this is known as a "packet switched path".

Applicants respectfully submit that nothing in the portions of Berken shown above, also specifically cited by the Office, nor any other figure or portion of Berken, teaches or suggests "...wherein digital voice data packets comprise information used for routing the digital voice data packets...", as asserted by the Office with regard to Applicants' claims 22, 28, 29, 36, and 47, or "...wherein the digital voice data packets comprises [sic] destination information...", as asserted by the Office with regard to Applicants' claims 43 and 51.

Applicants respectfully note that with respect to the rejection of Applicants' claim 43, the Office cites Berken at FIG. 9, at column 3, lines 20-40; at column 5, lines 34-46; and at column 6, lines 52-65. Applicants respectfully submit that the listed citations do not make sense, because Berken does not contain a "FIG. 9", and because Berken is formatted by pages, not by numbered columns, and lines numbered above 34 do not exist on any pages in Berken. Therefore, Applicants respectfully submit that the rejections based on those citations are improper and invalid. Applicants respectfully request that the Office provide corrected citations, if the Office chooses to pursue the rejection.

The Office action suggests that the "...control time slot of the transmit/receive frame comprises control information for routing/forwarding through PSTN, ... or Token Ring LAN)..." teaches Applicants' "...information used for routing the digital voice data

packets...", and "...destination information used for routing the digital voice data packets..." (page 4, lines 4-7; page 6, lines 4-8; page 8, lines 5-14) Applicants respectfully disagree.

Applicants respectfully submit that there is no "...control time slot of the transmit/receive frame..." but, rather "control time slots". Applicants respectfully submit that Berken clearly shows in Fig. 3 that the "node transmit" and "node receive" groups each have "control time slots", and that according to Berken, the "control time slot" is used to request allocation and de-allocation of bandwidth on the shared communication path. (page 9 at lines 18-27). As is well known in the art, a "packet" may be defined as "...[a] unit of information transmitted as a whole from one device to another on a network..." (See, e.g., Microsoft Press Computer Dictionary - Third Edition, 1997, Microsoft Corporation) Applicants respectfully submit that the "frame" of Berken is not analogous to a "packet", a term recited in Applicants claims 22, 28, 29, 36, 43, 47, and 51. Instead, the frame of Berken is a certain period of time, which has been divided into a number of slots of time that are allocated for various uses. Berken clearly states that "...[t]he frame shown in Fig. 2 is made up of a fixed number of time slots. Fig. 3 shows how the time slots are divided into two basic groups; node transmit and node receive." (page 9, lines 1-3) Each of these groups is made up of control, voice, and data time slots. Berken teaches that different time slots of a group may be allocated for use by different "user modules" and "interface units." (page 10, line 17-30) Therefore, neither Berken's "transmit/receive frame" nor the "node transmit" and "node receive" groups are analogous to a "packet", as recited in Applicants' claims 22, 28, 29, 36, 43, 47, and 51.

In addition, Applicants respectfully submit that the "control time slots" are not a part of a voice packet, but are used in Berken to exchange requests for allocation and de-allocation of the shared bandwidth of the communication path. Nothing in Berken, however, teaches that the "control time slots" comprise "...information used for routing the digital voice data packets...", in accordance with Applicants' claims 22, 28, 29, 36, 43, 47, and 51.

Based at least upon the above, Applicants respectfully submit that the Office has failed to show where the proposed combination Berken and Richter teaches or suggests

, "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets ...", as recited by Applicants' claims 22 and 28; "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets through the communication network....", as recited in Applicants' claim 29. Applicants also respectfully submit that the Office has failed to show where the proposed combination Berken and Richter teaches or suggests "...wherein the digital voice data is packetized according to a packet protocol comprising destination information used for routing the digital voice data packetized according to the packet protocol through the communication network...", as recited by Applicants' claim 36, and "...wherein the digital voice packets comprise destination information used for routing the digital voice packets through the network...", as recited by Applicants' claim 47. In addition, Applicants respectfully submit that the Office has failed to show where the proposed combination Berken and Richter teaches or suggests "...wherein the digital voice packets comprise destination information used for routing the digital voice packets through the network...", as recited by Applicants' claim 51. Therefore, Applicants respectfully submit that the proposed combination or references fails to teach or suggest each and every limitation of Applicants' claims 22, 28, 29, 36, 43, 47, and 51, as required by M.P.E.P. §2142, and that the Office has, therefore, failed to establish a prima facie case of obviousness.

In addition, Applicants respectfully submit that the stated motivation for modifying Berken with Richter is not a valid motivation for making the combination. As stated above with regard to claims 22, 28, 29, 36, 43, 47, and 51, Applicants appreciate recognition by the Office that Berken "...does not explicitly disclose destination." (Office action at page 4) Also as set forth above, Applicants have assumed that the Office intended to state, with respect to claims 43 and 51, that Berken "...does not explicitly disclose destination." However, in an attempt to overcome this shortcoming of Berken, the Office turned to Richter, stating that "...Richter teaches wherein the digital voice packets comprise destination information used for routing..." (page 4, lines 11-15) The Office continues stating that "...therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide destination, as taught

by Berken [sic] and well established teaching in art in the system of Berken, so that it would provide capability to the caller and callee to hear each other; see Richter col. 7, line 10-19, and it would also identify and locate the recipient of the voice data packet." (e.g., Office action at page 4, lines 16-20) Applicants respectfully disagree.

Applicants respectfully submit that the Office identified the alleged motivations for modifying the system of Berken using Richter as "...so that [Berken's "Wireless In-Building Telecommunications System] would provide capability to the caller and callee to hear each other..." and "...it would also identify and locate the recipient of the voice data packet..." Applicants respectfully submit that the alleged motivations for making the combination are not valid motivations, in that the system of Berken already (according to the Office) supposedly functions to "...provide capability to the caller and callee to hear each other..." and "...and identify and locate the recipient of the voice data packet..." Applicants respectfully submit that Berken discloses "...[a] wireless in-building telecommunication system for voice and data communications..." (Summary) Applicants respectfully submit that the Office has also made the apparent contradictory assertion that Berken teaches all of the limitations of Applicants' claims 22-73, with the admitted exception that "...Berken does not explicitly disclose destination..." (Office action at page 4) Based upon this assertion, Applicants respectfully submit that Berken must then function to, at least, "...provide capability to the caller and callee to hear each other..." and "...identify and locate the recipient of the voice data packet..." Applicants respectfully submit that if Berken did not function to "...provide capability to the caller and callee to hear each other..." and "...identify and locate the recipient of the voice data packet...", so that Richter would be needed, then the system of Berken would also not teach the features of Applicants claims 22, 28, 29, 36, 43, 47, and 51. Therefore, Applicants respectfully submit that the alleged motivations to modify Richter with Berken to "...provide capability to the caller and callee to hear each other..." and "...identify and locate the recipient of the voice data packet..." are not valid or proper motivations for one of ordinary skill in the art to seek to modify Berken using the teachings of Richter. According to the Office, Berken is supposedly functional to perform the above, as disclosed. Based at least upon the above, Applicants respectfully submit that the Office

has failed to identify "...some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings...", as required by M.P.E.P. §2142, and that the Office has failed to establish a prima facie case of obviousness.

In light of the above, Applicants respectfully submit that the Richter reference was chosen without a valid or proper motivation, and instead, was chosen because it allegedly discloses what the Office believes to be the one feature of Applicants' claims 22, 28, 29, 36, 43, 47, and 51, namely "destination", admitted by the Office to be missing from Berken. Moreover, to the extent the Office relies on a combination of Berken and Richter to reject Applicants' claims as was done, the Office is necessarily admitting that Berken does not disclose the elements of Applicant's claims 22, 28, 29, 36, 43, 47, and 51, as asserted.

Applicants respectfully submit that M.P.E.P. 2141 (II)(B) states, in part, "references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." This is also supported in case law, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Weslau*, 353 F.2d 238, 241 (United States Court of Customs and Patent Appeals, 1965) (emphasis added).

Therefore, Applicants respectfully submit that Applicants' claims 22, 28, 29, 36, 43, 47, and 51 are allowable over the proposed combination of Berken and Richter, for at least the reasons set forth above. Applicants respectfully submit that claims 23-27, 30-35, 37-42, 44-46, 48-50, and 52-59 depend either directly or indirectly from independent claims 22, 29, 36, 43, 47, and 51, respectively.

Applicants respectfully submit that the Office has failed to show where any combination of Berken with Richter, Harrison, Weaver, Perkins, and Cripps remedies the above-identified shortcomings of the proposed combination of the Berken and Richter references. Therefore, Applicants respectfully submit that the proposed combination of Berken with Richter, and any of Harrison, Weaver, Perkins, and Cripps,

fails to teach or suggest all of the limitations of Applicants claims 22, 28, 29, 36, 43, 47, and 51, and any claims that depend therefrom.

Because claims 23-27, 30-35, 37-42, 44-46, 48-50, and 52-59 depend from independent claims 22, 29, 36, 43, 47, and 51, Applicants respectfully submit that claims 23-27, 30-35, 37-42, 44-46, 48-50, and 52-59 are also allowable, for at least the reasons set forth above. Therefore, Applicants respectfully request that the rejections of claims 22-59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Claims 60, 61, 62, and 68-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton et al. (US 6,108,704, hereinafter "Hutton"). Applicants respectfully traverse the rejection. Notwithstanding, Applicants have amended claim 60 as shown above, to more clearly describe the subject matter of the claim.

As amended, claim 60 recites "[o]ne or more circuits for use in a handheld communication device supporting the exchange of voice over a communication network, the one or more circuits comprising at least one interface to circuitry for transmitting and receiving over a radio frequency channel, packets comprising packetized digital voice data according to a packet protocol; and at least one processor operably coupled to the at least one interface, the at least one processor operating to, at least, convert analog voice signals at a first user location to first digital voice data; packetize the first digital voice data according to the packet protocol to produce first digital voice data packets, wherein the first digital voice data packets comprise destination information used for routing the first digital voice data packets through the communication network to a second user, and wherein the first digital voice data is not packetized for transmission when representative of audio signals below a predetermined threshold level; wirelessly transmit, in accordance with a wireless communication protocol, the first digital voice data packets; wirelessly receive, in accordance with the wireless communication protocol, second digital voice data packets; depacketize the second digital voice data packets to produce second digital voice data; and convert the second digital voice data to analog voice signals at the location of the first user."

Applicants respectfully submit that the proposed combination of Berken and Hutton fails to teach, suggest, or disclose, at least, "...wherein the first digital voice data is not packetized for transmission when representative of audio signals below a predetermined threshold level...", as recited by Applicants' amended claim 60. Applicants respectfully submit that Berken discloses "...a wireless in-building telecommunication system for voice and data communication." (Berken at Abstract) Applicants respectfully submit that Hutton discloses "[a] point-to-point Internet protocol which exchanges Internet Protocol (IP) addresses between processing units to establish a point-to-point communication link between the processing units through the Internet." (Hutton at Summary) Both Berken and Hutton are silent, however, with regards to the subject of packetization of digital voice data representative of audio signals below a predetermined threshold.

Based at least upon the above, Applicants respectfully submit that the proposed combination of Berken and Hutton fails to teach each and every limitation of Applicants' amended claim 60, as required by M.P.E.P. §2142, that a prima facie case of obviousness has not been established, and that a rejection of claim 60 under 35 U.S.C. §103(a) cannot be maintained.

Therefore, Applicants believe that claim 60 is allowable over the proposed combination of Berken and Hutton, for at least the reasons set forth above. Applicants respectfully submit that claims 61-73 depend from allowable claim 60, and that claims 60, 61, 62, and 68-73 are therefore also allowable, for at least the same reasons. Applicants respectfully request, therefore, that the rejection of claims 60, 61, 62, and 68-73 under 35 U.S.C. §103(a), be reconsidered and withdrawn.

Claims 63-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, and further in view of Lewen (US 5,341,374, hereinafter "Lewen") Claim 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Lewen, and further in view of McKee (US 5,477,531, hereinafter "McKee"). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, and further in view of Cripps. Applicants

respectfully traverse the rejections. Applicants respectfully submit that claims 63-65, 66, and 67 depend either directly or indirectly from claim 60. Applicants believe that claim 60 is allowable over the proposed combinations of Berken, Hutton, Lewen, McKee, and Cripps, in that Lewen, McKee and Cripps fail to overcome the deficiencies of Berken and Hutton set forth above. Because claims 63-65, 66, and 67 depend from allowable claim 60, Applicants respectfully submit that claims 63-65, 66, and 67 are allowable as well, for at least the same reasons. Therefore, Applicants respectfully request that the rejections of claims 63-65, 66, and 67 under 35 U.S.C. §103(a), be reconsidered and withdrawn.

“Original” Rejections Under 35 U.S.C. §103(a)

The Office action lists at page 19-28 a number of rejections of claims in the Application under the heading of “Original Rejection”. Applicants respectfully request an explanation of the meaning of the heading, since a rejection under 35 U.S.C. §103(a) of claims 22, 27-29, 32, 35, 36, 39, 42, 47, 50, 51 and 54 over the proposed combination of Weaver and Richter has not previously been set forth during prosecution of the Application, but a rejection under 35 U.S.C. §103(a) of claims 43 and 46 over the proposed combination of Weaver and Harrison has been previously made (see Office action mailed May 2, 2006), to which Applicants have already responded (see Response filed September 5, 2006).

With respect to the instant Office action, claims 22, 27-29, 32, 35, 36, 39, 42, 47, 50, 51 and 54 were rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver in view of Richter. Claims 23, 24, 30, 31, 37, 38, 48, 49, 52, and 53 were rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver in view of Richter and Perkins. Claims 25, 33, 40, and 55-59 were rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver in view of Richter and Cripps. Claims 26, 34, and 41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver in view of Richter and Honig et al. (US 5,481,533, hereinafter “Honig”). Claims 43 and 46 were rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver in view of Harrison. Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being

Appln. No. 10/701,865
Filed: November 5, 2003
Reply to Office action mailed July 9, 2007
Amendment filed January 9, 2008

unpatentable over Weaver in view of Harrison and Perkins. Applicants respectfully traverse the rejections.

With respect to the rejections of claims 22-42 and 47-59 over the listed combinations that include Richter, Applicants respectfully submit that Richter is not a valid prior art reference, for at least the reasons set forth above. Therefore, Applicants respectfully request that the rejections of claims 22-42 and 47-59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

With respect to the rejections of claims 43 and 46 under 35 U.S.C. §103(a) over the proposed combination of Weaver and Harrison, and of claims 44 and 45 over Weaver, Harrison and Perkins, Applicants respectfully submit that these rejections are verbatim copies of the rejections of claims 43-46 set forth in the Office action mailed May 2, 2006, to which Applicants responded on September 5, 2006. The Applicants respectfully traverse the rejections for at least the reasons set forth during prior prosecution, and maintain that the claims of the Application describe patentable subject matter. For reasons of brevity and clarity, Applicants hereby incorporate herein Applicants' prior responses of record in the Application.

Appln. No. 10/701,865
Filed: November 5, 2003
Reply to Office action mailed July 9, 2007
Amendment filed January 9, 2008

Conclusion

In general, the Office Action makes various statements regarding claims 22-73 and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-73 define patentable subject matter and are in condition for allowance.

Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees required by this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

Dated: January 9, 2008

/Kevin E. Borg/
Kevin E. Borg
Reg. No. 51,486

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, Illinois 60661
Phone (312) 775-8000
Facsimile (312) 775-8100